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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,714	06/04/2001	Morenike Awokola	FA1002 US NA	4978

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EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,714

Applicant(s)

AWOKOLA ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003 and 01 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

Amendment filed on March 27, 2003 and April 1, 2003 have been entered. Claims 11 and 12 have been cancelled. New claim 13 has been added. Claims 1-10, 13 are pending in the application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Rejection of claim 9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,387,519).

Anderson et al is applied herein for the reasons of record as set forth in Paragraphs No. 4 and 6 of the Office Action mailed on December 27, 2002 (Paper No. 5). Anderson et al further teach that a coating composition may formulated as a powder as solvent-based coating compositions, water-based coating compositions, in solid particulate form, that is, a powder

coating composition (i.e. without any solvent), or in the form of a powder slurry or aqueous dispersion (See column 40, lines 19-23). However, Anderson et al fail to teach that the powder slurry or non-solvent coating composition can be prepared from a mixture of polymeric powders and polysiloxane of formula (I) in a liquid-form so that in a formed powder slurry it would act as a reactive diluent.

It should be noted that a component of formula (I), when $(n+m) = 2$ and R1 and R2 are of low molecular weight (See column 18, lines 37-67; column 19, lines 60-67), is in fact a silane monomer in a liquid form. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formulated a coating composition of Anderson et al as a non-solvent powder slurry act with the silane monomer acting as a reactive diluent since Anderson et al teach that a coating composition may be formulated as a non-solvent composition or a powder slurry.

As to the process being a repair coating, Anderson et al teach "Also provided are methods for **revitalizing** the gloss of a polymeric substrate or **polymeric coating** comprising **forming over** at least a **portion** of the polymeric substrate or **polymeric coating** any of the foregoing cured compositions according to the present invention." (See column 4, lines 8-23). Clearly this teaching includes claimed *repair coating* of a substrate since a polymeric coating can exist only on a substrate.

As to claim 13, a process is used in automobile coatings (See column 42, lines 8-21, 44-67).

5. **Claims 7, 8** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,387,519) in view of Harris et al (US 5,596,043) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on December 27, 2002 (Paper No. 5).

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6. **Claims 9, 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,387,519) in view of Richard (US 5,091,211) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on December 27, 2002 (Paper No. 5).

Response to Arguments

7. Applicants' arguments filed April 1, 2003 have been fully considered but they are not persuasive.

(i) Applicants argue that a coating composition of Anderson et al must contain particles, wherein the particles are useful for increasing scratch resistance, while applicants' invention has no such requirement but rather directed to a repair coatings of substrates.

The Examiner respectfully disagrees with this argument. First of all, applicants' invention also must contain particles because it is a filler coating composition. Secondly, applicants' invention is also scratch resistant since it is substantially identical to that of coating composition of Anderson et al. Moreover, a repair coating is supposed to be scratch resistant since it is for repair coating of automotive body.

It is held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, *claimed properties or functions are presumed to be inherent*. See MPEP 2111.02, 2112.01. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

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(ii) Applicants argue that polysiloxane (I) of Anderson et al, which is a component (B) according to the Examiner is not a monomer diluent as claimed.

The Examiner respectfully disagrees with this argument. Since Anderson et al teach **at least one** polysiloxane of formula (I), the Examiner took the position that both components (A) and (B) are of the same formula (I). So even if (B) of the formula (I) is a reactive diluent, it does not exclude (A) being a powder because formula (I) covers a very wide spectrum of compounds.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy
Examiner
Art Unit 1762

May 9, 2003



SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
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